

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

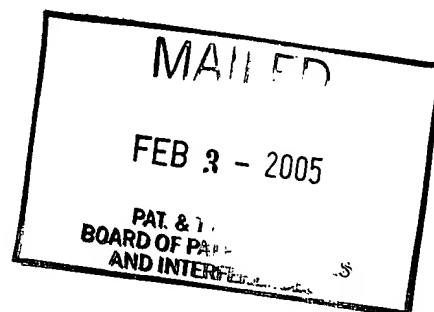
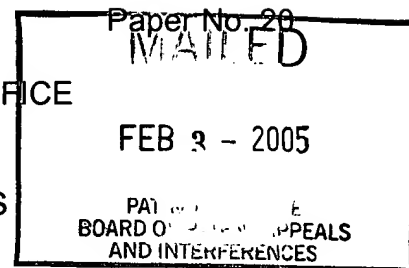
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ALAN SLATER

Appeal No. 2005-0033  
Application No. 09/384,678

ON BRIEF



Before JERRY SMITH, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.  
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-50, which are all the claims in the application.

We affirm-in-part.

### BACKGROUND

The invention relates to a system and method for third party (i.e., a "service provider") assumption of Internet checking and savings account transactions on behalf of a merchant that provides goods or services to a customer. Representative claim 1 is reproduced below.

1. A method for assumption by a service provider of at least one merchant function in a financial transaction between a customer and a merchant, comprising:

receiving information about the financial transaction by the service provider for the merchant;

automatically identifying an intended recipient of the information by the service provider for the merchant; and

automatically sending the information to the intended recipient by the service provider for the merchant.

The examiner relies on the following references:

Elliott et al. (Elliott)	5,036,461	Jul. 30, 1991
Rosen	5,455,407	Oct. 3, 1995

Claims 1-50 stand rejected under 35 U.S.C. § 102 as being anticipated by Elliott and by Rosen.

We refer to the Final Rejection (Paper No. 13) and the Examiner's Answer (Paper No. 18) for a statement of the examiner's position and to the Brief (Paper No. 17) for appellant's position with respect to the claims which stand rejected.

OPINION

Appellant submits (Brief at 6) that claims 1 through 48 comprise one group of claims for our consideration in this appeal, with claims 49 and 50 comprising another. Moreover, although the Brief repeats limitations of claims within the group that comprises claims 1 through 48, appellant's remarks do not meet the requirements for arguments for separate patentability of the respective claims. Accordingly, we select instant claim 1 as representative of the first group of claims. See 37 CFR § 1.192(c)(7) (1997). See also In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.").

With respect to the subject matter of claims 49 and 50, we refer to appellant's arguments in the Brief in defense of the claims. The examiner contends that the claims are "clearly anticipated" by both Elliott and Rosen, but neither expresses findings in support of the rejections nor answers appellant's arguments presented in the Brief. Further, the rejection of claims 1 through 50 over Rosen contends that all claims are anticipated -- somewhere, presumably, in the fifty-six columns of text and fifty-plus figures. Again, however, the rejection does not set forth findings with respect to Rosen, nor answer appellant's arguments in the Brief. Because a prima facie case for anticipation has not been established, we do not sustain the rejection of claims 1

through 50 under 35 U.S.C. § 102 as being anticipated by Rosen, nor the rejection of claims 49 and 50 under 35 U.S.C. § 102 as being anticipated by Elliott.

We next consider instant claim 1 and the teachings of the Elliott reference. Elliott discloses a point-of-sale transaction device 10 (Figs. 1 and 2). A plurality of connectors (Fig. 2) receive program modules to be supplied by card agencies for executing transactions with cards issued by that agency. The program modules are obtained by the merchant that uses transaction device 10. Col. 3, l. 45 - col. 4, l. 3. Figure 3 shows the electronics within transaction device 10. Device 10 includes microprocessor 18, which controls and coordinates operation of the transaction device. The transaction device may include interface devices 42, 44 for interfacing the device with transaction (e.g., credit) cards. Device 10 may also be capable of providing "on line" transactions, by means of communication module 51 for data communications with a remote computer. Col. 4, ll. 4-68.

The examiner finds (Answer at 3-5) that the claimed "service provider" reads on microprocessor 18. We agree with the examiner that Elliot teaches, as required by instant claim 1, receiving information about the financial transaction, by microprocessor 18, for the merchant. Elliot further teaches that the intended recipient of the information is automatically identified, and that the information is automatically sent to the intended recipient by microprocessor 18, at least in the case of an "on line" transaction as described by the reference.

We note that the Answer identifies the “service provider” in Elliott, although the Final Rejection does not. Appellant has not been unfairly prejudiced, however, as appellant could have submitted a Reply Brief if appellant wished to show that the examiner’s findings in the Answer should be considered erroneous. In any event, we consider the examiner’s position to be reasonable.

We find that appellant’s specification, at the bottom of page 3, indicates that a service provider “can be” -- i.e., is not necessarily -- a financial institution. We are also mindful that the claimed “service provider” is not a person or legal entity, such as a financial institution, but is an apparatus (e.g., server 16, depicted in instant Fig. 3) that is provided by, or under the ownership or control of, the entity. Thus, microprocessor 18, collecting information for the intended recipient at the behest of those who provide transaction device 10 to the merchant, is fairly considered a “service provider” within the meaning of instant claim 1.

Appellant’s arguments in the Brief do not persuade us of error in the rejection of representative claim 1. The arguments do not rebut the examiner’s position as revealed in the Answer. We sustain the rejection of claims 1 through 48 under 35 U.S.C. § 102 as being anticipated by Elliott.



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